

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 41, 42, 44-47, 50, 51, 53, 54, 60, 63, 66-72, 75-78, 80, 81, 94 and 95 are pending in the application, with 41, 63, 75 and 78 being the independent claims. Claims 64 and 65 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Applicants reserve the right to file divisional applications to the canceled subject matter. New claims 94 and 95 are sought to be added. Support for these new claims can be found, *inter alia*, in original claims 41 and 75, at page 12, lines 15-17, and at page 38, lines 22-26 of the specification as filed. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. *Scope of Group I*

The Examiner is of the opinion that "[t]he Group I elected invention . . . which is drawn to the compound of formula I wherein . . . A is phenyl or carbocyclic aryl, B is indolo . . ." Office Action, page 2, lines 3-5. Applicants respectfully disagree.

Applicants submit the scope of Group I includes, *inter alia*, the compounds of formula I, wherein A is *optionally substituted C₆₋₁₄ aryl*; and B is *optionally substituted indolo ring*. Claims with this scope were allowed prior to the filing of the Request for

Continued Examination on March 31, 2004. Applicants respectfully request correction of Examiner's characterization of the scope of Group I.

II. Restriction Requirement

Claims 64 and 65 have been restricted out from examination. The Examiner stated "[t]he restriction requirement is revised to also restrict out claims 64-65 from examination since these claims are drawn to multiple active ingredients. The restriction is FINAL." Office Action, page 2, lines 7-9. Applicants respectfully traverse this further requirement of restriction and request reconsideration. 37 C.F.R. § 1.143.

However, in the interest of expediting the allowance of the present application, claims 64-65 have been canceled.

III. Obviousness-Type Double Patenting Rejections

Claims 41, 42, 44-47, 50, 51, 53, 54, 60, 63 and 66-72 are provisionally rejected under an obviousness-type double patenting rejection as allegedly being unpatentable over claims 17, 19, 20, 21-28 and 81 of copending U.S. Patent Application Publication No. 2003/0065018 (Appl. Ser. No. 10/146,138, Cai *et al.*) ("co-pending application"). See Office Action, page 2, line 10, through page 3, line 6. Applicants respectfully traverse this rejection.

Also, claims 75-78 have been provisionally rejected under an obviousness-type double patenting rejection as allegedly being unpatentable over claims 75-78 of

copending U.S. Patent Application Publication No. 2003/0065018. *See* Office Action, page 3, lines 7-14. Applicants respectfully traverse this rejection.

If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

M.P.E.P. 804 (2004). The Examiner has raised two provisional double patenting rejections as the only outstanding rejections in the present application. According to M.P.E.P. 804, these rejections should be withdrawn from the current application and raised in the co-pending application after the current application issues as a patent. The current application and its prosecution have been cited in Information Disclosure Statements (filed March 27, 2003 and August 23, 2004) in the co-pending application. Applicants submit the provisional double patenting rejections of claims 41, 42, 44-47, 50, 51, 53, 54, 60, 63, 66-72 and 75-78 are improper and request that they be withdrawn.

Furthermore, Applicants submit that alleged claims 75, 76, 77, 78 and 81 of the co-pending application cited by the Examiner in the above rejections do not exist. The cited co-pending application contains claims 1-46 only. Applicants submit the provisional double patenting rejections of claims 41, 42, 44-47, 50, 51, 53, 54, 60, 63, 66-72 and 75-78 are improper and request that they be withdrawn.

IV. Applicants' Information Disclosure Statement filed March 31, 2004

Applicants submitted an Information Disclosure Statement (IDS) on March 31, 2004. No acknowledgement of the IDS was made by the Examiner in the Office Action

dated May 18, 2004. The Examiner did not initial and return the Forms PTO-1449. "An information disclosure statement *shall* be considered by the Office if filed by the applicant . . . [b]efore the mailing of a first Office action after the filing of a request for continued examination under § 1.114." 37 C.F.R. § 1.97(b)(4) (2004) (emphasis added). The Examiner has no discretion in considering the documents submitted in Applicants' IDS filed with a Request for Continued Examination on March 31, 2004, which is before the May 18, 2004 mailing date of the present Action. Applicants respectfully request the Examiner consider all documents cited in Applicants' IDS of March 31, 2004 and initial off on the Forms PTO-1449 and return them to Applicants.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,
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